

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

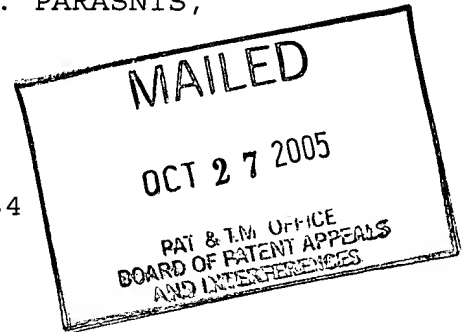
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANJIT N. NOTANI, ABHAY V. PARASNIS,
and MARK B. WHIPPLE

Appeal No. 2005-1873
Application No. 09/156,334

ON BRIEF



Before KRASS, BARRETT and NAPPI, Administrative Patent Judges.
KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-7, 10-12, 15-20, and 48.

The invention pertains to the field of supply chain, enterprise and site planning; in particular, to a computer-implemented system for managing collaborations across multiple nodes of one or more enterprises.

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Representative independent claim 2 is reproduced as follows:

2. A computer-implemented process operable, when executing on a computer system, to manage a distributed workflow to perform a set of predefined, executable software functions:

the computer-implemented process operable, when executing on a computer system, to store a set of predefined, executable software functions for a workflow that are to be performed at a plurality of distributed nodes;

the computer-implemented process operable, when executing on a computer system, to manage the workflow by automatically interacting with the workflow at each of the distributed nodes to perform the predefined, executable software functions; and

the set of predefined, executable software functions operable to generate a workflow between a plurality of enterprises.

The examiner relies on the following references:

Randell

5,745,687

April 28, 1998

Teschler, Leland "Demo proves it--workflow spec lets messages flow"
Machine Design v68n15, (August 22, 1996) pp. 74-75.

Claims 1-7, 10-12, 15-20, and 48 stand rejected under 35
U.S.C. § 103 as unpatentable over Randell in view of Teschler.

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Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the examiner must produce a factual basis supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The examiner may satisfy his/her burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

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The examiner alleges that Randell discloses the instant subject matter but for physically separated entities. The examiner turns to Teschler for such a teaching, at page 1, lines 10-24, viz., a workflow interoperability specification to allow physically separated enterprises to communicate workflow data for the benefit of sharing tasks between one or more companies.

The examiner concludes that it would have been obvious to use the workflow interoperability specification to allow physically separated enterprises to communicate workflow data for the benefit of sharing tasks between one or more companies in the Randell system.

Appellants disagree.

It is appellants' view that Randell fails to disclose the claimed "predefined, executable software functions," disclosing instead, data defining an activity being communicated from a computer system to an agent so that the agent can perform the activity. Appellants assert that Randell nowhere discloses or suggests that its computer system interacts with one of the distributed nodes associated with one of the plurality of

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physically separated enterprises through performance of the one or more predefined, executable software functions at the distributed node, as recited, in claim 1.

Moreover, appellants assert, Teschler fails to make up for the deficiencies of Randell because Teschler merely discloses information about the status and flow of projects being sent back and forth between entities but does not teach or suggest that this information includes the "predefined executable software functions" recited in the instant claims, or the operations involving the predefined, executable software functions, such as interacting with one of the distributed nodes associated with one of the plurality of physically separated enterprises through performance of the one or more predefined, executable software functions at the distributed node (see pages 9-10 of the principal brief).

We have considered the evidence before us, including the cited references and the arguments of appellants and the examiner, and we conclude that the examiner has not established a prima facie case of obviousness with regard to the instant claimed subject matter.

While, in our view, the instant claims are broad in the sense that no specific enterprise is recited, no specific collaborations are recited, and no specific software functions are recited, the burden is still on the examiner, in the first instance, to establish that the broad elements, steps, and functions, along with their interrelationships, that are claimed are suggested by the applied prior art.

Claims 1-4 require, inter alia, a "set of predefined, executable software functions" for generating a workflow between a plurality of enterprises. Yet, it is not clear to us where the examiner finds such limitation in the applied art. The examiner contends that the set of predefined executable software functions is taught by Randell in Figure 10B at element 1024 (see, for example, page 3 of the answer). But reference to this portion of Randell finds a box labeled "CREATE EVENT." The attendant descriptive passage in the patent specification is at column 13, lines 3-5, and reads: "If the node is an event generator node, block 1022 transfers to block 1024 which creates the event and send it on a logical channel." We find nothing recited therein indicative of the claimed "set of predefined, executable software functions."

In response to appellants' arguments on this point, the examiner responds with a reference to Randell's abstract, lines 3-4, and column 2, lines 50-56. The cited abstract portion recites that "Agents may be individual users, work groups, organizations or automatic systems. Automation is used to guarantee that all the individual activities are taken in the defined sequence, form, and time." The cited portion of column 2 recites "The above and other aspects of the invention are accomplished in a process automation, or workflow, system that automates the definition and execution of a procedure, wherein the procedure can carried out (sic, can be carried out?) according to defined rules among agents." We find nothing in either of these two portions of Randell indicative of the claimed "set of predefined, executable software functions" for generating a workflow between a plurality of enterprises.

The examiner also cites column 14, lines 56-61, of Randell (see page 5 of the answer). This portion of Randell recites the receipt of "...a reply from the external organization service process, which includes the agent and possibly other information..." While this may suggest some communication between two entities, at best, we find nothing herein directed to any "set

of predefined, executable software functions" for generating a workflow between a plurality of enterprises.

The examiner does not appear to make any attempt to specifically point out what it is in Randell which is being taken as the equivalent to the claimed "set of predefined, executable software functions" for generating a workflow between a plurality of enterprises. Appellants appear to think that the examiner is equating the disclosed "agents" in Randell with the claimed "set of predefined, executable software functions" (see page 4 of the reply brief). If this is, indeed, what the examiner intends, we are not persuaded. Randell defines the agent as being "individual users, work groups, organizations or automatic systems" (Randell-abstract). We find none of these listed entities which may comprise an "agent" to constitute a "set of predefined, executable software functions," as claimed.

Moreover, even if Randell did suggest the claimed "set of predefined, executable software functions," the examiner has not established a sufficient reason for combining the applied references. Rather, the examiner merely contends that Randell discloses the claimed subject matter but for physically separated enterprises, that Teschler discloses a communication between two physically separated enterprises, and that it would have been

obvious to employ Teschler's teaching in the Randell system. However, even assuming that the references disclose everything the examiner says they disclose, no rationale is given by the examiner as to why the skilled artisan would have been led to make the combination, nor as to how, exactly, Randell is to be modified.

Since the examiner has failed to establish a prior art disclosure or suggestion of at least one of the claimed elements, and has provided insufficient support for combining the references, we will not sustain the rejection of claims 1-4 under 35 U.S.C. § 103.

With regard to independent claims 5 and 48, and the claims dependent thereon, the examiner asserts that Figure 12 of Randell discloses the receiving at a computer system a preliminary collaboration from a first participant, and that Figure 10A, element 1012, discloses the claimed "automatically transmitting the preliminary collaboration to a second participant," as well as the claimed "automatically transmit the response of the second participant to the first participant," with Figure 12, elements 1208, 1222, and Figure 14, element 1408, disclosing the claimed "receiving a response to the preliminary collaboration from the second participant." Receiving the response to the response ultimately resulting in the final collaboration based on the

preliminary collaboration and optimized for the first and second enterprises, is said to be taught by Randell at Figure 12, element 1224, and Figure 13.

Again, the examiner asserts that Teschler provides for the teaching of a first and second enterprise, which is lacking in Randell, and concludes that it would have been obvious to combine these references in order to result in the instant claimed subject matter.

At pages 13-14 of the principal brief, appellants argue that the references fail to disclose receiving, transmitting, or responding to, a "preliminary collaboration," as claimed.

We have reviewed the evidence before us and conclude therefrom that the examiner has, again, failed to present a prima facie case of obviousness with regard to the instant claimed subject matter.

We have reviewed Randell, especially the portions cited by the examiner, and we fail to find the claimed "preliminary collaboration," and the various functions related thereto. Moreover, Teschler does not remedy this deficiency in Randell.

We agree with appellants that the cited portions of Randell merely disclose entry conditions for starting an activity, wherein if the entry conditions are satisfied, the activity is assigned to an agent and an information packet associated with the activity is sent to the agent, whereupon the agent completes the activity and returns the information packet (see page 14 of the principal brief). However, we can find nothing relating to the claimed "preliminary collaboration" having the steps set forth in the claims and resulting in a "final collaboration."

The examiner's response to these arguments, at page 6 of the answer, is not persuasive. The examiner asserts that Randell discloses the preliminary collaboration in Figure 12, elements 1222 and 1208, in the satisfaction or return of the packet as unaccepted. The examiner argues that the "final collaboration" is disclosed by Randell by the satisfaction with the current task and the placement of the next node in the work queue which continues, as in Figure 13's conditional loop, waiting for all nodes to be completed.

At pages 8-9 of the reply brief, appellants point out that these cited portions of Randell cannot constitute a "collaboration," as claimed, because two parties are not involved. For example, an activity at step 1208, wherein a packet of

information is rejected, never gets assigned to an agent for completion, whereas an activity at step 1222, having exit conditions, has been completed by an agent. Either way, there seems to be one party involved and these two conditions would appear to be mutually exclusive. Since these two conditions are separate, they cannot be placed together, if this is what the examiner has in mind, as "a preliminary collaboration." We agree with appellants, at page 9 of the reply brief, when they argue that a "single agent" has completed an activity having exit conditions evaluated at step 1222, and that a "single" agent cannot constitute a "collaboration."

In addition, as appellants point out, at page 9 of the reply brief, there is no "final collaboration" suggested in Randell since, at step 1308, waiting for all previous nodes to complete, Randell waits for completion of all nodes ahead of the routing node in a work queue before executing the routing node to select output nodes for placement into the work queue. Therefore, since it appears that only the workflow execution software executes the routing node at step 1308, this cannot properly be considered a "final collaboration" based on a preliminary collaboration, as there is no "collaboration," at all. We also agree with appellants (page 9 of the reply brief) that step 1308 does not appear to be related to the work node in the dispatch task process in Randell,

so it does not appear reasonable for the examiner to hold that routing step 1308 is "final collaboration based on the preliminary collaboration," as required by claim 5. The examiner present us with no convincing argument to this rather reasonable contention by appellants.

Accordingly, we will not sustain the rejection of claims 5-7, 10-12, and 48 under 35 U.S.C. § 103.

With regard to independent claim 15, and claims 16-19 dependent thereon, the examiner asserts the same reasoning as applied above, with the addition of citing column 14, lines 43-64, of Randell for the proposition that communication with an external system could be with a third participant.

Independent claim 15 recites, inter alia, a "final collaboration" approved by first, second, and third enterprises. Since the examiner has not persuaded us of any "final collaboration" in Randell (or Teschler for that matter), for the reasons supra, we also will not sustain the rejection of claims 15-19 under 35 U.S.C. § 103.

Finally, turning to independent claim 20, the examiner relies on Figures 12 and 14 of Randell to disclose the instant claimed

subject matter but for a first and second enterprise, the suggestion for which the examiner relies on Teschler.

Appellants contend that the combination of references fails to disclose or suggest a computer implemented process operable to receive a first predefined set of data having been collected in response to an automatic query of the first node for the first set of data; and to receive a second predefined set of data having been collected in response to an automatic query of the second node for a second set of data.

The examiner responds by identifying Figure 14, elements 1406, 1408, and column 15, lines 7-20, of Randell for data in packets that are dispatched and replied to.

While the cited portions of Randell suggest some cooperation between two parties working on a packet of information, we find nothing therein indicative of the claimed computer implemented process operable to receive a first predefined set of data having been collected in response to an automatic query of the first node for the first set of data; and to receive a second predefined set of data having been collected in response to an automatic query of the second node for a second set of data.

Moreover, for the reasons set forth by appellants, at pages 13-14 of the reply brief, we find that the examiner has failed to establish a showing in the combined references of the first and second predefined sets of data.

Further, we are not convinced of any reasonable showing by the examiner as to why the skilled artisan would have made the combination asserted by the examiner.

Accordingly, we will not sustain the rejection of claim 20 under 35 U.S.C. § 103.

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Since we have not sustained the rejection of any of the claims
under 35 U.S.C. § 103, the examiner's decision is reversed.

REVERSED



ERROL A. KRASS)
Administrative Patent Judge)

) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES



ROBERT NAPPI)
Administrative Patent Judge)

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BARRETT, Administrative Patent Judge, concurring.

I agree that the examiner has failed to establish a prima facie case of obviousness over the combination of Randell as modified by Teschler. However, I write separately to express my opinion that at least claim 2 is so broad that it appears to be anticipated by Teschler alone, as set forth below.

<u>Claim 2</u>	<u>Teschler</u>
2. A computer-implemented process operable, when executing on a computer system, to manage a distributed workflow to perform a set of predefined, executable software functions:	Teschler describes a "Workflow Interoperability" Specification "for software from different vendors to communicate about the status and flow of projects, their 'workflow.'" The term "software" indicates that the process is computer-implemented. "The demonstrations involved sending information back and forth as it might flow between entities such as retailers, distributors, and manufacturers," which indicates management of a "distributed workflow."
the computer-implemented process operable, when executing on a computer system, to store a set of predefined, executable software functions for a workflow that are to be performed at a plurality of distributed nodes;	"The simulated tasks that took place included such actions as checking order status, receiving notification of completed actions, updating inventory information, and other book-keeping associated with projects, goods, or services that span between more than one company or department." "The term 'workflow software' refers to packages that basically keep track of projects or act as coordinators of events moving through different stages of completion. Such packages generally track such factors as

project status, delay times, commitments made by participants, waiting times, and similar issues." "The new specification is designed so that interoperability functions easily add to existing software without modifying core functions."

The predefined tasks performed by the workflow software ("interoperability functions" such as checking order status, receiving notification of completed, etc.) are "a set of predefined executable software functions." The tasks are performed between different companies or departments, which constitute a "plurality of distributed nodes."

the computer-implemented process operable, when executing on a computer system, to manage the workflow by automatically interacting with the workflow at each of the distributed nodes to perform the predefined, executable software functions; and

the set of predefined, executable software functions operable to generate a workflow between a plurality of enterprises.

The workflow software performs the "predefined, executable software functions" to manage the workflow at the distribute nodes.

The purpose of the functions performed by the workflow software is to generate a workflow between a plurality of companies or departments.

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I recommend that the examiner consider making such a rejection.



LEE E. BARRETT

Administrative Patent Judge

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